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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,748	03/21/2001	James M. Evans	3847-67823	4685

7590

01/16/2003

Barnes & Thornburg
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Indianapolis, IN 46204

EXAMINER

WESSMAN, ANDREW E

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 01/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,748

Applicant(s)

EVANS ET AL.

Examiner

Andrew E Wessman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other:

DETAILED ACTION

1. Claims 1-32 remain for examination. Claims 10, 11, 21, and 28 have been amended.

2. In view of the amendment to the claims, the objections to the claims and the rejection under 35 U.S.C. 112, 1st paragraph have been withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "reduced" in claim 1 is a relative term which renders the claim indefinite. The term "reduced" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Despite applicant's submission of references to define the current state of the art in the field of die soldering, one of ordinary skill in the art would still not be apprised of what the term "reduced" would imply. It is unclear what the die solderability of the alloy is reduced compared to. Such a relative term without any numerical data or comparison basis is meaningless, and it is suggested that such relative language be removed from the claim, or some basis for comparison be recited.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 15-18, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishi et al.

Nishi et al. is applied to the claims for the reasons set forth in paper No. 7, paragraph 11.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-6, 12-14, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishi et al. in view of Evans et al.

Nishi et al. in view of Evans et al. is applied to the claims for the reasons set forth in paper No. 7, paragraph 13.

10. Claims 7-11 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishi et al. in view of Evans et al., and further in view of Witters et al.

Nishi et al. in view of Evans et al., and further in view of Witters et al. is applied to the claims for the reasons set forth in paper No. 7, paragraph 14.

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11. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishi et al. in view of Evans et al., and further in view of JP '142.

Nishi et al. in view of Evans et al., and further in view of JP '142 is applied to the claims for the reasons set forth in paper No. 7, paragraph 15.

12. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishi et al. in view of Evans et al., in view of JP '142, and further in view of Witters et al.

Nishi et al. in view of Evans et al., in view of JP '142, and further in view of Witters et al. is applied to the claims for the reasons set forth in paper No. 7, paragraph 16.

Response to Arguments

13. Applicant's arguments filed November 18, 2002 have been fully considered but they are not persuasive. In the remarks, applicant argues:

(1) Nishi et al. fails to disclose reduced die soldering in die casting operations;
and

(2) Nishi et al. fails to disclose an aluminum die casting alloy with a certain percentage of iron and less of manganese in unmodified form, and then less than 0.6% iron in modified form and 1-2 wt% manganese in modified form.

With regards to applicant's argument (1), Nishi et al. teaches an alloy having the same compositional limitations as the claimed invention. Because the composition of the alloy of Nishi et al. and the claimed invention are the same, and there is no further distinction between the alloys made, the alloy of Nishi et al. would inherently have the

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claimed reduced die soldering. It has been held that if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 2d 1655, 1658 (Fed. Cir. 1990). In this case, because no other limitations to the claimed invention are present aside from the compositional limitations, the properties claimed would have been inherently present in the alloy of Nishi et al.

With regards to applicant's argument (2), the properties of the claimed invention are based on the final composition of the alloy. Because the claimed invention is a product, the patentability is based upon the properties of the product itself, and not upon the starting material. The alloy of Nishi et al. and the claimed invention are substantially the same. The claims are essentially directed towards a method of improving the die castability of a die cast aluminum alloy by reducing the die solderability by adding manganese to an alloy containing lower amounts of iron. Because Nishi et al. teaches such an alloy, and presumably such an alloy has been produced from some starting material and not simply mined in the given composition, the claimed invention has been taught in the prior art.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew E Wessman whose telephone number is (703)305-3163. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703)308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

AEW
January 15, 2003


ROY KING
SUPERVISORY PATENT EXAMINER
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